

In the United States Patent And Trademark Office

Appl. Number: 09/978,215
Appl. Filed: 10/15/01
Applicant: Luis J. Rodriguez
Title: Self Sealing Forms
Examiner / GAU: Stephen P. Garbe / 3727

RECEIVED

JAN 13 2003

TECHNOLOGY CENTER R3700

PETITION TO COMMISSIONER

Applicant very respectfully requests, under 37 CFR 1.183 as it is required by Justice, any suspension of rules related to any eventual untimeliness of this Petition, given the following considerations:

- 1) This is a pro-se case. Applicant is doing his best, but this case has been exceptionally taxing and applicant has had a double burden: to learn and then to do, while attending all his other responsibilities.
- 2) Applicant had misinterpreted the periods for reply.
- 3) Applicant has had to respond to Office Communications related to four different cases during this lapse of time, as it is reflected by the records of the following cases: 09/978,240; 09/978264; 09/812,664, and of course this one with interview of 10/29/02 and its subsequent Summary. **(EXHIBIT F)**
- 4) There has been a high number of Holidays during this time.
- 5) Fee is enclosed.
- 6) Along this Petition, applicant is filing a Notice of Appeal.

In reference to the above application, Pro-se applicant hereby respectfully submits a **petition to overrule Examiner's actions**, and invokes the **Commissioner's supervisory authority** under 37 CFR 1.181.

I. Introduction. Reasons For This Petition.

Pro-Se applicant respectfully submits, as supported by the facts listed below and the entire record that:

- 1) The depth of the examination has been inadequate, as it has not been consonant with

BEST AVAILABLE COPY

the patent laws and rules, and it has therefore inequitably affected this case, and as a result, has unduly imposed and continues to impose an excessive procedural and financial burden on applicant.

- 2)** Although applicant has exhausted all possible efforts and resources, to adequately communicate with the Examiner, Examiner has only provided 'non sequitur' and contradicting responses, expressed in vague stereotyped terms or, no acknowledgment or responses at all.

This unresponsiveness by the Office has obviously prompted a yet more comprehensive reply by applicant progressively growing each time, only to receive the same 'non-sequitur' responses expressed in vague stereotyped terms, or no acknowledgment or responses at all.

- 3)** There has been a predisposition towards this case, and a systematic determination to *a priori* dismiss it, as it is also supported by the facts listed below and the entire record.
- 4)** The unfairness of this case is readily evident upon reading Applicant's Summary of Oct. 29/02 Interview, (**EXHIBIT F** attached herewith) which reports that applicant undisputably proved to the Examiner improper rulings made by the Examiner, and that Examiner opted for inaction and not to reverse such rulings.

This unequivocally proves that the examiner's determination is that '*no matter what*', this case is to be dismissed. Applicant respectfully submits that this is grossly unfair.

II. Facts. *These facts unquestionably prove that none of the arguments submitted by applicant in response to Office actions has been accurately acknowledged (If at all acknowledged) and even less, properly addressed by the Office in a substantive and responsive manner; which clearly indicates that the examination of this case has not been equitable.*

- 1)** Application was titled: "Self Sealing Forms", and it discloses business forms, letters, and similar articles that do not require to be contained and covered by an envelope.

- 2)** Applicant has applied for another completely different patent, under the title "Self Sealing Containers" (#09/978,264) which discloses completely different products, namely: envelopes, boxes and other types of containers. This case is also being examined by Mr. Garbe. The relevance of mentioning this case here will be apparent later in this Petition. (*In # 4 under this section*)
- 3)** Office action of March 11, 2002 rejected all claims under 102 and/or 103 (in eventual addition to other 112 rejections) citing always at least one envelope as prior art to this invention.

To indicate the differences between the claimed invention and an envelope, applicant submitted some explanations via telefax on 03/20/02. (Incorporated into Amendment A. Please, see page 14, last para., page 15, and first four paragraphs of page 16)

Shortly after that, Examiner replied to these explanations, in a recorded voice message, stating:

"Your definition is not specific. It says: '*The term form encompasses letters, documents, forms and any type of correspondence*'. The envelope that I am using in the rejection is encompassed by that terminology." (See Amendment A, page 16, 5th para.)

This reply is not responsive, and it is not pertinent in any way, because:

- a)** It does not address any substantive issue submitted with applicant's arguments of 03/20/02.
- b)** It only expresses the Examiner's interpretation of the word "correspondence", vs. applicant's interpretation of the word, but more importantly, it does it in clear contradiction of the specification's nomenclature. (Please, see MPEP 2111.01)

This clearly establishes that arguments submitted by applicant were not considered, and hence that the case is not being fairly examined. (Please, see MPEP 2144.08) This further supports applicant's contention that there is a predisposition in this case, and

that a very liberal semantic interpretation, repugnant to the meanings in the specification is simply used as a pretext for claim rejections. This has been consistently the core of the Examiner's rejections.

- 4) During interview sessions of March 20 and April 01/02, examiner suggested to add a score line to some claims, to presumably define over an alleged combination of Schieman and Tissot, used as a 103 rejection also during that interview session.

Applicant indicated that since that score line was not indispensable for the invention, that such suggestion was not believed to have a fair effect.

Examiner replied that if applicant disagreed, that applicant could appeal the issue to the Board of Appeals.

Examiner also stated that 60% of the cases examined by Examiner were allowed as patents.

Applicant was and is puzzled by this statement, as the patent system is not about quotas, but about merits, or lack thereof.

This puzzling feeling was exacerbated by the fact that the Examiner is examining two different cases by applicant, and if this 60%/40% ratio must be applied, one of these two applications was guaranteed to be rejected regardless of any reasoning or arguments presented.

During a subsequent interview, and again regarding the issue of fairness, examiner stated: *"I allowed you some claims in the other case, didn't I?"*

This other statement elevated applicant's puzzling feeling to a troubling level.

Applicant respectfully submits to the Commissioner that the only relevant percentage is to fairly examine 100% of applications, and that the only fair goal, according to patent law is to allow 100% of allowable cases and to reject 100% of non-allowable cases.

- 5) Examiner inquired why applicant had applied for a patent, and commented that normally a product is first developed as such.

Although confused by this question applicant replied that had he not applied for a patent, Guest (US Pat 6,290,120) and Guest (US Appl. 2001/0032872A1), cited by Examiner, would have precluded filing or at least could have interfered with it.

6) Office Action of March 11/02 rejected claims 7-9, 11, 12, 14 and 15 under 103(a) as unpatentable over Fisher 4,487,360 in view of Schieman 2,367,440.

- Please, see O.A. of 03/11/02, Section 11 (2nd para. of page 5)
- Please, see O.A. of 03/11/02, Section 12 (3rd para. of page 5)
- Please, see O.A. of 03/11/02, Section 13 (4th para. of page 5)

Applicant addressed these rejections with comprehensive and detailed arguments. (Please, see pages 32-38 of amendment A)

Office action of June 20/02 incorrectly states that Fisher has not been applied as a reference, and that therefore the arguments submitted by applicant are moot. (Please, see O.A. of 06/20/02, 3rd para. of page 11)

This flagrant contradiction is another proof of the superficiality of this examination.

Amendment B pointed out to this contradiction (Please, see page 26, 5th para.)

However, subsequent O.A. did not address this issue at all, which proves even further the superficiality of this examination.

7) Office action of June 20/02 replied to Affidavits submitted under oath in an incoherent and confusing manner, and did not offer any substantive response.

Amendment B pointed out to this issue (Please see pages 26-27), however, subsequent O.A, did not address it at all.

This lack of response further proves the superficiality of this examination.

8) In response to applicant's inquiries about appealing procedures, Examiner stated that normally, a "Request for Continued Examination" (RCE) was filed before appealing.

Applicant filed a RCE as Amendment B.

- 9)** Amendment B (RCE), included a 'Substitute Specification' with its corresponding 'no New Matter Statement'.

Office denied entry of the Substitute Specification, alleging that the phrase "relates to a blank" was new matter.

As indicated by Amendment C and later during phone interview of Oct. 29/02, this is not new matter as the term 'blank' was recited by original claim 17; and that even if something in the Substitute Specification was deemed to be 'new matter', Office should request its cancellation.

Refusal to enter the Substitute specification was unfair, as the reasons given were improper and incorrect.

- 10)** Amendment B responded to all the objections and/or rejections of Office Action of June 20/02, with arguments and elaborated visual aids and graphic materials. Namely:

- Attachment 11A: Illustrated Comparison of Construction of Schieman's envelope (First Embodiment) with this invention
- Attachment 11B: Illustrated Comparison of Construction of Schieman's envelope (Second Embodiment) with this invention
- Attachment 12: Illustrated Comparison of structural components of Schieman's envelope with this invention
- Attachment 13: Comments to first embodiment
- Attachment 14: Two sided leaflet of Self Sealing Form with additional marginal comments.

However, subsequent O.A. (dated September 11/02) did not acknowledge, and even less address any of these arguments or attachments. Instead, it trivialized applicant's efforts by incorrectly summarizing arguments in Amendment B with the following statement: "The primary argument [is] that the claimed invention does not have panels" (Please, see O.A. of 09/11/02; page 7, 3rd paragraph)

This statement is incorrect in every respect as discussed in detail in Amendment C, (Please, see pages 68-72).

These reasons clearly establish that the finality of O.A. of 09/11/02 was improper.

11) O.A. of June 20 (Page 11, 2nd para.) specifically required that applicant pointed out the structural differences of the claimed invention.

Amendment B fully and exhaustively complied with this express requirement with arguments on pages 14-15 and, and with the illustrated attachments referenced above.

None of these arguments or probative attachments was acknowledged at all and even less, replied to. Instead, O.A. of September 09/11, incorrectly states that applicant focuses on what the invention is not, rather on what the invention is[*]. This prompted a yet more comprehensive response, in the form of Amendment C, including new and more detailed attachments, depicting even more clearly and categorically "What the Invention Is", "How To use The Invention" and Differences of the Invention with the Cited References, as follows:

- **ATTACHMENT 15:** An illustrated discussion of "What the Invention Is"
- **ATTACHMENT 16:** An illustrated discussion about "How to Use the Invention"
- **ATTACHMENT 17:** Cross reference of substitute specification with original specification.
- **ATTACHMENT 18:** A downloaded image of a pre-printed blank check, for use with laser or inkjet printers, retrieved from:
[Http://www.nebs.com/ecatimages/full/9209.gif](http://www.nebs.com/ecatimages/full/9209.gif)
- **ATTACHMENT 19:** A downloaded image of a pre-printed blank account statement for use with laser or inkjet printers, retrieved from:
<http://www.nebs.com/ecatimages/full/13446T.gif>
- **ATTACHMENT 20:** Photocopy of back panel of "Self Seal Mailer's" package by Avery

[] Any clarification that applicant has made of what the invention is not, is in response to Office's allegation that the invention is an envelope.*

Dennison, showing the mode of operation.

- **ATTACHMENT 21:** Illustrated comparison of Schieman's first embodiment with this invention.
- **ATTACHMENT 22:** ILLUSTRATED comparison of Schieman's second embodiment with this invention.
- **ATTACHMENT 23:** Illustrated comparison of Wilbur's first embodiment with this invention.
- **ATTACHMENT 24:** Illustrated comparison of Wilbur's second embodiment with this invention.
- **ATTACHMENT 25:** Updated illustrated comparison of Schieman's first embodiment's construction with this invention.
- **ATTACHMENT 26:** Updated illustrated comparison of Schieman's second embodiment's construction with this invention.
- **ATTACHMENT 27:** Updated illustrated comparison of both Schieman's embodiments number of layers with this invention's.
- **ATTACHMENT 28:** Illustrated comparison of both Wilbur's embodiments number of layers with this invention's.
- **ATTACHMENT 29:** Updated Illustrated comparison of paper used (Envelope + Form vs. Self Sealing Form/ '215)
- **ATTACHMENT 30:** Updated illustrated comments to first embodiment
- **ATTACHMENT 31:** List of amended claims, consolidated with their dependents.

ATTACHMENT 15, titled "**What The Invention Is**" is of a particular value in terms of responding to the Office's erroneous contention that 'applicant focuses on what the invention is NOT' as it clearly points out in the simplest (illustrated) terms what the

invention is. **It is so simple that it tells the story, even if the captions are not read.**
And it further does it in the context of the known prior art.

ATTACHMENT 16 is also very important, as it indicates '**How to USE the invention**', which clearly establishes that some elements that the Office contends that are in the claimed invention, are NOT, as they are rather a function of its use.

ATTACHMENT 17 is very significant to this petition. In addition to proving that there is no new matter in the substitute specification, **ATTACHMENT 17** is clear evidence of the excessive burden that applicant has had to assume in this case. **ATTACHMENT 17** is a proactive effort by applicant to prevent any other undue allegations of "new matter" by the Office.

None of these probative attachments as none of the other very important attachments in Amendment C, and none of the many arguments submitted with Amendment C, received any consideration by the Examiner, as the entire Amendment C was improperly denied entry alleging that claim 45 introduced 'new matter'. Specifically, that the elimination of "at least" in claim 45 raised a new issue. As pointed out in the "Summary of the Invention" submitted as **EXHIBIT F**, this elimination only satisfied a requirement of a previous O.A.[*], and hence, it could not possibly be "new matter".

And as a result of this unfounded determination, none of the pleads or other requests by applicant received a response by the examiner. Specifically:

- Amendment C requested reconsideration of finality of last O.A. (Please, page 21, 4th para. [numeral 3]), page 73, 2nd para., page 75 5th para.)

A response to this request was not received.

- Amendment C requested a substantive response to the arguments submitted with Amendment A and Amendment B, which were never addressed by the Office. (They were not even acknowledged)

A response to this request was not received.

- Amendment C, requested entry of Amendment C, and consideration of its arguments (page 21, 1st para.) (page 75, last para.)

[*] Which was also erroneous and improper as noted in **EXHIBIT F**.

Amendment C was improperly denied entry, as explained above.

- Amendment C requested entry of Substitute Specification (page 1, 1st para. after salutation; page 75, 5th para.)

A response to this request was not received.

- Amendment C requested entry of amended claims submitted with Amendment C (page 575, last paragraph) indicating that these (**narrowed**) claims were in better condition for allowance, and explained why (page 26 of Amendment C.)

All claims were dismissed under improper allegations that claim 45 raised new issues. (Please, see **EXHIBIT F**)

12) On October 29, 2002 a telephonic interview took place.

As reflected by the "Summary of the Interview", (**EXHIBIT F**) and insofar as all the issues discussed, applicant proved to Examiner the inappropriateness of all the Examiner's allegations and, hence the invalidity of any resultant ruling.

However, Examiner did not offer any reconsideration, or reversed any of the rulings.

This is unquestionable proof of a predisposition and a systematic determination to no matter what, dismiss this case. Applicant respectfully submits that that is simply not fair.

13) This predisposition and determination to dismiss this case is further proven by the Examiner's Summary of the interview, because:

- a) it reports that all the claims were discussed, which is simply not true, and
- b) it fails to report what in reality was discussed (Please, see enclosed **EXHIBIT F**)

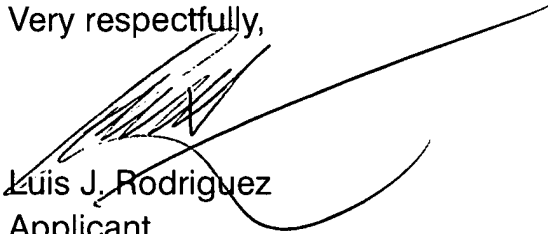
III. Actions Requested

Supported by all the preceding reasons, considerations, and arguments, and his legitimate right to a fair examination, applicant very respectfully requests the following actions:

- Withdrawal of the Finality of the last Office Action
- Entry of the Substitute Specification submitted with the RCE of August 24, 2002
(Amendment B)
- Entry of **Amendment C**. Or in lieu of that:
 - Entry of **EXHIBITS B, C, D, and E** (models of references cited by Office)
 - Entry of **ATTACHMENT 15**
 - Entry of **ATTACHMENT 16**
 - Entry of **ATTACHMENT 17**
 - Entry of **ATTACHMENT 18**
 - Entry of **ATTACHMENT 19**
 - Entry of **ATTACHMENT 20**
 - Entry of **ATTACHMENT 21**
 - Entry of **ATTACHMENT 22**
 - Entry of **ATTACHMENT 23**
 - Entry of **ATTACHMENT 24**
 - Entry of **ATTACHMENT 25**
 - Entry of **ATTACHMENT 26**
 - Entry of **ATTACHMENT 27**
 - Entry of **ATTACHMENT 28**
 - Entry of **ATTACHMENT 29**

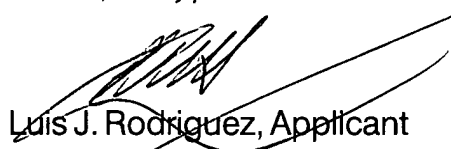
- Entry of **ATTACHMENT 30**
- Entry of **ATTACHMENT 31**
- Entry of **AFFIDAVIT 4**
- A substantive response to all the issues in Amendment C, and the unresponded issues in Amendment B and A.
- Any other action that the Commissioner may find fair and appropriate.

Very respectfully,



Luis J. Rodriguez
Applicant

DECLARATION: *I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of any application, any patent issuing thereon, or any patent to which this verified statement is directed.*



Luis J. Rodriguez, Applicant
January 09, 2003

Date of Mailing: January 9, 2003

I hereby certify that this correspondence, including its attachments is being deposited with the United States Postal Service "EXPRESS MAIL TO ADDRESSEE" service # **EU444558142US** under 37 CFR 1.10 on the date indicated above, and is addressed to the Commissioner for Patents, Box AF, Washington, D.C. 20231



Luis J. Rodriguez, Applicant

In The United States Patent And Trademark Office

App. Number: 09/978,215
Appl. Filed: 10/15/01
Applicant: Luis J. Rodriguez
Title: Self Sealing Forms
Examiner / GAU: Stephen P. Garbe / 3727

EXHIBIT F
EXHIBIT F

Summary of Interview

Type of Interview: Telephonic
Date of Interview: October 29, 2002
Participants: Luis Rodriguez (Applicant)
Stephen Garbe (Examiner)

RECEIVED
JAN 13 2003

TECHNOLOGY CENTER R3700

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

Applicant very respectfully submits a summary of the interview referenced above, as follows:

- 1) Regarding the Advisory Action dated 10/25/02, and particularly the Examiner's allegation that the "elimination of 'at least one', in claim 45 raises a new issue", which was used as the basis to refuse entry of Amendment C, applicant pointed out that Office Action of September 11/02 rejected the same claim 45 under 35 USC 112 for adding "at least", and that therefore refusal to enter Amendment C obviously lacks any proper basis, because "elimination of 'at least one' could only overcome the previous rejection.[*]

Applicant respectfully complained about the contradicting actions of the Office, and indicated that they have had a clearly unfair effect in the prosecution of this case, and particularly referred

[*] So there is no confusion on the record:

Applicant elected to remove "at least" from claim 45, instead of disputing the rejection. The September 11/02 rejection was also improper as there were more than adequate antecedents for the expression "at least" (one body) in the original specification, which disclosed more than one body in the 13th and 14th embodiment examples (Figs. 24's and 25's, and corresponding text), and as extensively discussed in Amendment C.

to this instance, since Amendment C, which contains valuable factual information to explain and advance this case for allowance, was refused entry for one of these improper reasons.

Applicant stated that this case felt like a 'catch 22' situation.

- 2)** Regarding the Office Action of September 11/02, Applicant inquired about Examiner's allegation that the phrase "relates to a blank" constituted new matter in the substitute specification of Aug. 23/02, and his refusal to enter it, pointing out that 'a blank' was **not** new matter, as it was literally recited by original claim 17, and that therefore refusal to enter the substitute specification was improper.

Applicant also indicated that **ATTACHMENT 17** ("*Cross Reference of Substitute Specification to Original Specification*") discusses each individual amendment made by addition, referencing each entry to the specific location where it was discussed in the original specification, and/or offering a legal explanation where pertinent or necessary.

Examiner indicated that if the clarification regarding 'letter size' (on page 1 of Substitute Specification) was not in the original specification, that it would constitute new matter.

Applicant replied that while new *language* was certainly used, no new matter was introduced (Applicant again referred the Examiner to **ATTACHMENT 17**).

And that the reason for this is that the original title "***Self Sealing Forms***" does not inherently convey the size restricting effects as the term "**Letter**" does, because the term "**Letter**", is commonly used to designate **8½" by 11"** pieces of paper. And that without the clarification, the amended disclosure may be interpreted to apply **exclusively** to forms (or letter sheets) of **8½" x 11"** size, limitation that **was not** in the original disclosure.

And that all this clarification does is to prevent the original disclosure to be unduly restricted to an 8½" x 11" letter size by the Substitute Specification.

Applicant officially and formally re-stated that there is no new matter in the specification as sworn in the "*Statement of No New Matter*" filed with the "*Request for Continued Examination*".

- 3) Only** claims 50 and 68 were discussed. (*The allusion to claim 45 in # 1) above related to the non-entry of the Amendment. Patentability of claim 45 was not discussed.*)

4) Regarding claim 50, applicant referred Examiner to page 39 of Amendment C, which illustrates claim 50 and all its elements as they relate to a drawing of the invention, in its most basic form.

Upon checking the referenced page, Examiner replied: "I won't allow claims of that scope"

Applicant inquired: "*Why not? That is a picture claim.*"

Examiner replied: "*I don't know what you mean by a picture claim*"

Applicant explained —*what (pro-se) applicant has gathered from different readings*— that a 'picture' claim essentially recites each and every element of the invention.

5) Regarding Claim 68, after reading the pertinent locations in original specification, as pointed out by applicant, Examiner admitted that the repositionable adhesive (204) had been disclosed in original specification (which established the invalidity of the rejection, and hence, the allowability of the claim).

However, Examiner stated that applicant should have indicated where the disclosure of repositionable adhesive was.

Applicant indicated that **Amendment C** pointed out to the many different specific locations in original specification where repositionable adhesive (**204**) was discussed.

6) Examiner mentioned that the application disclosed many different embodiments.

Applicant replied that there are no extension limits for a patent application.

Applicant also indicated that applicant has been diligent in addressing all the issues raised by the Office via arguments and/or amendments and that to assist the Office in examining this case, applicant has supplied numerous illustrated materials and visual aids, which graphically summarize the arguments and that judging by the Office Actions, they all appear to have been ignored by the Office.

Applicant respectfully complained about the depth of this case's examination, in view of the incoherence of Office's Actions with respect to applicant's and Office's own previous communications and stated: "It seems as if this case is not being examined at all"

- 7) Applicant requested that model of invention [submitted under 37 CFR 1.91(a)(3)] be compared with models of Schieman and Wilbur [submitted under 37 CFR 1.91(a)(1)]
- 8) In response to applicant's complaints, Examiner indicated that any disagreements should be presented to the Board of Appeals and Interferences, for arbitration.

Applicant replied that he intends to take that course of action, but that the refusal to enter the **Amendment C** and the **Substitute Specification** submitted with the Request for Continued Examination, can only be resolved by The Commissioner, upon Petition, and requested that Examiner reconsidered his decisions regarding these matters, so such procedure can be avoided.

Examiner inquired why applicant wanted the Substitute Specification entered.

Applicant replied that since it was apparent from Office's Actions that the Examiner has misunderstood the invention, as disclosed in the original specification, the specification needed to be amended to better teach the invention, to the Office and to the public.

Applicant further indicated that as per the MPEP, even if something in the substitute specification is perceived as 'new matter', such new matter needs to a) be properly identified, b) objected to and c) required to be canceled.

Applicant asserted his right to have the substitute specification submitted with RCE (amendment B) entered, especially in light of the fact that it contains no new matter and again referred the Examiner to **ATTACHMENT 17**, which is a cross reference of amendments to their initial discussion in the original specification.

-----END OF SUMMARY OF INTERVIEW-----

Luis J. Rodriguez (Applicant)
60 Fourth Street
South Orange, NJ 07079-1851
Tel. (973) 761-1300; Fax:(973) 761-6488

Signature: _____


Luis J. Rodriguez

CERTIFICATE OF MAILING:**Date of Mailing:** November 21, 2012

I hereby certify that this correspondence, including its attachments is being deposited with the United States Postal Service "EXPRESS MAIL TO ADDRESSEE" service **ET444555035US** under 37 CFR 1.10 on the date indicated above, and is addressed to Box AF, Commissioner for Patents, Washington, D.C. 20231

Luis J. Rodriguez, Applicant

Signed: _____

